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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,861	12/12/2001	Neil S. Cutshall	240083.514	2603

22504 7590 09/26/2005

DAVIS WRIGHT TREMAINE, LLP
2600 CENTURY SQUARE
1501 FOURTH AVENUE
SEATTLE, WA 98101-1688

EXAMINER

DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,861	CUTSHALL ET AL.	
	Examiner	Art Unit	
	Rita J. Desai	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-11,13-16 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8-11,13-16, 18-21, 23-30 is/are rejected.
- 7) ☒ Claim(s) 5,7 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1, 5-11, 13-16 and 18-30 are pending.

The rejection of claims 1, 5-11, 13-16, 19 and 30 over 35 USC 112 has been withdrawn since applicants have amended the R4 definition and specific hetero groups are exemplified for the R1 substituent.

The claims 1, 6, 10, 13, 16, 29 and 30 rejected under 35 USC 102 over DN 86:15920 Brzezinski Bogumil 1976 has been withdrawn since applicants have amended the claims wherein R1 is not an alkyl.

The rejection under DN 83:96958 over Bogumil 1995 has also been withdrawn since applicants have amended the claims.

The rejection over DN 97:144206 over Bogumil et al 1982 has also been withdrawn since applicants have amended the claims.

The rejection of the claims over US 4730051 (not US 4730,057) Ueda Yoichiro et al 1988 has also been withdrawn since applicants have amended the claims.

The rejection over US 4978385 1990 Yagihara et al has also been withdrawn due to the amendment.

The rejection under US 4787931 Henrie et al has also been withdrawn since applicants arguments are convincing that the reference teaches and discloses the urea compounds.

The rejection of claims 1, 6, 10,11, 13 ,16, 29 and 30 under 35 USC 102(e) over US 6794397 Cai et al however still stands.

Applicants arguments that the oxides are not enabled and disclosed is incorrect.

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See last compound in column 12, see example 28 in column 28 which disclose the N-oxide and a process of making it is also disclosed.

The rejection of claims 14, 18-28 obvious over US 4978385 has been withdrawn ,

However a new 103 rejection is being made over US 6794397 Cai et al.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 recites the limitation "R1 is an S alkyl" in claim 1 however R1 is R5-SO2..

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

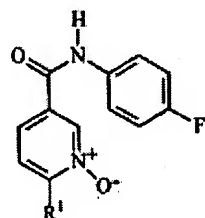
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 8-11, 13,14, 16-21, 23- 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6794397 Cai et al.

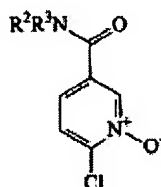
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Applicants compounds are drawn to compounds such as

43



(II).



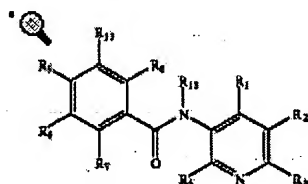
and

wherein R2 is a

hydrogen and R3 is an aryl substituted or unsubstituted.

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference teaches several compounds of the general formula



and several examples including the oxide form.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The reference teaches numerous similar compounds but not in the oxide form.

However it does teach the N-oxide form and discloses atleast one example 28.

The process is the oxidation of the N by hydrogen peroxide and trifluoroacetic anhydride.

Thus the process is also disclosed.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

Thus since the process and compounds without the oxides are disclosed and there is teaching of how to form the oxides, it would be prima facie obvious for one skill in the art to make the corresponding oxide compounds of the ones disclosed in the prior art.

Conclusion

The claims 1, 6, 8-11, 13,14, 16-21, 23- 29 and 30 are not found to be allowable.

Claims 5,7, 15, 22 are objected to as being dependent from a rejected claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday,9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
September 21, 2005

RJ Desai
9/21/05